



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/788,162

02/15/2001

Robert Anthony Luciano JR.

83336.1540

4032

55136

7590

04/16/2009

BALLY GAMING INC.
6601 S. BERMUDA ROAD
LAS VEGAS, NV 89119

EXAMINER

YOO, JASSON H

ART UNIT

PAPER NUMBER

3714

NOTIFICATION DATE

DELIVERY MODE

04/16/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jpcody@ballytech.com
mhein@ballytech.com
smoney@ballytech.com

Office Action Summary	Application No. 09/788,162	Applicant(s) LUCIANO ET AL.	
	Examiner Jasson H. Yoo	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 27 January 2009.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 153-156, 158-166 and 168-171 is/are pending in the application.

 4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 153-156, 158-166 and 168-171 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/27/09 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 153-156, 158-166, 168-171 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants' specification does not teach the limitation of, "game play enhancements available to the player **only** by way of the promotional award/data".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 153-155, 158-165, 168-171 are rejected under 35 U.S.C. 103(a) as being unpatentable Walker (US 6,227,972) in view of Crouch (US 5,580,053).

153, 162. Walker discloses a method for enhancing game play on a gaming machine by using a promotional award. The promotional award can be purchased by the player at face value, or at a discount, given out by the casino to the player for free, or issued to a player as part of a payout (cols. 4:61-5:9). The promotional award is used as game credits configures the game play by allowing the player to play more games or wager more credits using the promotional award. The gaming machine determines whether the promotional award is applicable on the gaming machine (determining if the satisfying conditions are met to access the balance, determining the awards are within the expiration period, determining if enough credits are available in the balance; step 710 in Fig. 7, cols. 3:47-65, 6:50-67:12, 8:1-9, 8:32-39, 10:5-61) when the gaming machine receives the promotional award from the player (player input that includes new promotional data is received in step 604 in Fig. 6A). However, Walker fails to disclose the promotional award is configured to add one or more game features to a game thereby altering the game from a base game state to an enhanced game state, wherein the game features are additional pay lines to the game, additional

winning indicia for the game, initiating play of a different game, or any combination thereof. Nevertheless such modifications would have been obvious to one of ordinary skilled in the art. Walker discloses the promotional award is used as game credits for at a gaming machine. There are many games that require game credits to alter the base game into an enhanced game. The enhanced game changes the rules of the base game by adding one or more game features to the base game. An example of a base game that can be altered by adding one or more game features in exchange for game credits is taught by Crouch. Crouch discloses a slot machine in which additional pay lines are added to the game for additional credits (col. 3:60-67). The base game is altered to an enhanced game where additional pay lines are in play in addition to the center pay line. Thus, by modifying Walker's gaming method of using promotional awards as game credits and Crouch's method of enhancing a base game by adding additional pay lines to the game in exchange for game credits, base games can be altered to an enhanced game with additional game features in exchange for promotional awards. Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to modify Walker's method of using promotional awards as game credits and incorporate Crouch's method of enhancing a base game by adding one or game features in order to provide the predictable result of using promotional awards to alter a base game by adding additional game features.

Walker in view of Crouch significantly discloses the claimed invention as discussed above. The combination of Walker and Crouch suggest that one or more game play enhancements are available to the player by using the promotional award

(When the promotional award is purchased by the player at face value, or at a discount, given out by the casino to the player for free, or issued to a player as part of a payout as discussed by Walker in cols. 4:61-5:9.), or by wagering additional money (purchase for the option of playing for win on lines other than the centre line; wagering additional tokens; Crouch, col. 3:30-67). However, Walker in view of Crouch fails to teach that the one or more game play enhancements are available to the player only by way of the promotional award. Nevertheless, using only the promotional awards to provide one or more game play enhancements, instead of using promotional awards and wagering money would have been obvious to one of ordinary skilled in the art since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. See *Ex parte Wu*. See also *In re Larson*, and *In re Kuhle*. For example, omitting the use of wagering money to provide the enhanced game state will leave the remaining element of promotional awards to provide the enhanced game state. Such instance would occur when the player does not have any additional wagering money to provide the enhanced game play, but has promotional awards to provide the enhanced game play.

Furthermore, a gaming operator would configure the game to be altered to the enhanced game state only by way of the promotional award in order to encourage players in obtaining promotional the awards. Therefore it would have been obvious to one of ordinary skilled in the art to modify Walker in view of Crouch's method for enhancing game player, and configure the game to add one or more game play

enhancements only by way of the promotional award since it involves only routine skill in the art and in order to encourage players in obtaining the promotional awards.

154, 164. Walker in view of Crouch discloses the promotional award includes time restriction data having a predetermined, fixed expiration date for the new promotional award (Walker, cols. 2:55-3:2, 5:10-6:35).

155, 165. Walker in view of Crouch discloses the promotional award includes location restriction data that restricts use of the new promotional award to a predetermined location or a predetermined set of locations (The promotional award or prepaid card is restricted to be used at the casino in which the prepaid card was received by the player, Walker, cols. 2:15-53, 3:3-46, 5:15-20).

158-159, 168-169. Walker in view of Crouch discloses the claimed invention as discussed above but fails to teach the following: reconfiguring the at least one game further comprises providing additional pay lines to the game, adding additional winning indicia to the game, triggering a secondary game, or any combination thereof; providing a new pay table for the game in response to the new promotional award; and applying a multiplier to any winning outcomes of the game. These game features are commonly known game features are that specific to the base game. For example: additional pay lines and secondary games are well known to be provided for slot machines when additional game credits are wagered. New pay tables and award multipliers are also

well known to be provided for extra game credits. The specific type of game features use on various base games is a design choice. When using Walker in view of Crouch's method of using promotional awards to alter a base game by adding additional game features on various base games, would require the game features to change according to the base game. For example, incorporating Walker's invention of using promotional award as gaming credits on a slot machine that has three pay lines, wherein each pay line normally require game credits, would allow the player to use the promotional award to activate the pay line. Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made and modify Walker in view of Crouch's method of enhancing a base game by adding one or game features and incorporate various game enhancements in order to provide the predictable result of enhancing a base according to the nature of the base game.

160, 170. Walker in view of Crouch discloses issuing a promotional award to the player during a gaming session (issued to a player as part of a payout on a slot machine, Walker, cols. 4:61-5:9).

161, 171. Walker in view of Crouch discloses issuing a promotional award to the player at the conclusion of a gaming session (issued to a player when the payout is awarded, Walker, cols. 4:61-5:9).

163. Walker in view of Crouch discloses accepting player identification (Walker, col. 7:22-37); and

retrieving new promotional data that is associated with the player identification (Walker, col. 7:38-57).

Claims 156 and 166 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US 6,227,972) in view of Crouch (US 5,580,053) as applied to claims 153 and 162 above, and further in view of Walker'765 (US 6,364,765).

156, 166. Walker'972 in view of Crouch discloses the method of or enhancing game play on a gaming machine using promotional awards as discussed above. Walker'972 in view of Crouch teaches the promotional awards are awarded to the players (Walker'972, col. 4:61-5:9) and to attract new customers and increase customer loyalty (Walker'972, col. 1:12-29). The promotional awards are also used to stimulate business in a casino during off-peak periods (Walker'972, col. 2:46-48). The casino can increase the customer loyalty with promotional awards and regulate the usage of promotional awards during off-peak periods by including restrictions such as an expiration time for the promotional awards, a time frame in which the players can use the promotional awards, or a minimum spending amount before the awards can be in effect (Walker'972, Figs. 5A-5B, col. 3:13-65). Furthermore, Walker'972 in view of Crouch discloses slot machines that can receive player's information and determine if the player is within limits set by the restriction fields and use the promotional awards (Walker'972,

step 616 Fig. 6A, col. 7:13-37, 7:59-8:9, 8:65-9:16). However, Walker'972 in view of Crouch does not specifically teach the restriction of the new promotional award to a particular game, a set of related games, a family of games, or a predetermined subset of games. In an analogous art to casino restrictions with awards Walker'765 discloses a method of playing a game where the casino restricts the usage to a particular game, a set of related games, a family of games, or a predetermined subset of games.

Walker'765 discloses certain games are played on specific slot machines or types of slot machines (Walker'765, cols. 7:3-8:15) in order for the casino operators to effectively utilize the valuable floor space of a casino. By encouraging player to move to higher profit machines or encouraging an idle player to play any machine, casinos can achieve a higher profit per machine. Directing slot players to particular machines also benefits players by enhancing or expanding their gaming experiences (Walker'765, col. 3:32-43). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Walker'972 in view of Crouch's gaming method and incorporate a location restriction, restricting the usage to a particular game, a set of related games, a family of games, or a predetermined subset of games, in order to utilize the floor space of a casino and encourage players to move to higher profit machines.

Response to Arguments

Applicant's arguments with respect to claims 153-156, 158-166, 167-171 have been considered but are moot in view of the new ground(s) of rejection. New grounds of rejections have been made to address the amended limitations.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jasson H. Yoo whose telephone number is (571)272-5563. The examiner can normally be reached on 9:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 09/788,162
Art Unit: 3714

Page 11

/Peter D. Vo/
Supervisory Patent Examiner, Art Unit 3714